

CUSTOMER NO. 46850

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Furquan Ansari et al.

Re: Attorney Docket No. Ansari 1-2

Serial No.: 10/766,164

Group Art Unit: 2153

Filed: 1/28/04

Examiner: Yasin M. Bargadle

Matter No.: 990.0492

Phone No.: 571-272-3947

For: Endpoint Address Change in a Packet Network

APPELLANT'S REPLY BRIEF UNDER 37 CFR 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22213-1450

Dear Sir:

In response to the Examiner's Answer filed on 10/20/08, Appellant/Applicant submits the following Reply Brief in support of the appeal:

APPELLANT'S REPLY BRIEF

This Reply Brief is filed to address particular issues raised in the Examiner's Answer. While the discussion below specifically addresses only certain issues in this Appeal, the Appellant maintains all of the arguments previously submitted in Appellant's Brief, including those not specifically discussed herein.

1. ALLOWABLE CLAIMS

The Applicant respectfully notes that, on page 20 of the Examiner's Answer, the Examiner indicated that claims 6 and 7 recite allowable subject matter, and the Examiner withdrew the rejections of these claims.

2. ARGUMENT

A. Gannage is Not Analogous Art

On page 20 of the Examiner's Answer, the Examiner asserts that Gannage is analogous art, citing *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), for the proposition that "a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention." The Applicant respectfully submits that Gannage is neither in the field of the Applicant's endeavor, nor reasonably pertinent to the particular problem with which the Applicant is concerned.

The Examiner argues that Gannage is analogous art because "it deals with mobile endpoints and non-migrator endpoints that communicating each other via IP network." It is respectfully submitted that this is a mischaracterization of Gannage. The terms "mobile endpoints," "non-migrator endpoints," and "migrator" are not used anywhere in Gannage, nor does Gannage ever address the issue of mobility of an endpoint in a communications network, or how such mobility might be handled. The Examiner appears to be arguing that, because Gannage involves the use of a packet-based network to send voice data from one terminal to another, Gannage is in the Applicant's field of endeavor, which is the migration of a session across addresses in a packet network. The only commonality between Gannage and the present application is the involvement of a packet network. The Examiner therefore appears to be asserting that packet-based communications is the common field of endeavor of both the Applicant and Gannage. However, packet-based communications is far too broad to be reasonably considered as a "field of endeavor." Indeed, this argument is as illogical as arguing, e.g., that a microcomputer and an electric heater are in the same field of

endeavor, simply because both devices run on 120-volt alternating current. The field of endeavor of the Applicant is not the entire field of packet-based communications, but rather, the field of migration of a session across addresses in packet-based communications. Likewise, the field of endeavor of Gannage is also not the entire field of packet-based communications, but rather, the field of voice communications in a packet network. It is unreasonable and improper to assume that one working in the Applicant's field of endeavor could possibly be presumed to have knowledge of a reference such as Gannage, in an unrelated field. Since the present application and Gannage are not in the same field of endeavor, the first *Oetiker* criterion is not met.

Curiously, the Examiner argues on page 21 that “[c]hanging IP addresses for a mobile endpoints as it moves from one location is well known in the art as disclosed by Fonata. Therefore, the Appellant’s argument that Gannage is non-analogous is not persuasive.” The fact that the Fonata reference might be relevant to the Applicant’s field of endeavor is completely unrelated to the issue of whether the Gannage reference is relevant to the Applicant’s field of endeavor, which it is not.

Nor is the second *Oetiker* criterion met, because Gannage is not reasonably pertinent to the particular problem with which the Applicant is concerned. In particular, Gannage is concerned with the problem of transferring voice over data channels, e.g., for telephone conferencing, while the present invention is concerned with the problem of changing endpoint addresses. One skilled in the art of the Applicant would not have turned to Gannage for guidance regarding changing endpoint addresses, just as one skilled in the art of Gannage would not have turned to references involving changing endpoint addresses, such as Funato or the present application, for guidance regarding transferring voice over data channels. Since the present application and Gannage are not reasonably pertinent to solving the same particular problem, the second *Oetiker* criterion is not met.

Therefore, Gannage is not properly combinable with Funato or any other reference to reject any claim of the present application, and this combination of references used to reject claim 1 in the present application is in error.

B. No Proper Motivation to Combine Has Been Provided

The Examiner continues to argue supposed advantages of combining Gannage and Funato. However, not only do the cited references fail to support these supposed advantages, the cited references actually clearly refute them and show that they are nonsensical.

The first motivation argued by the Examiner is that one skilled in the art “would have readily recognized the desirability and advantage of modifying Funato by employing the separate channel notification system of Gannage to prevent overloading the existing session channel between the migrator and non-migrator with notification information.” As fully discussed in the Appeal Brief, this motivation is nonsensical, because there is no disclosure in Funato or Gannage to suggest that overloading an existing session with notification information is a problem at all, let alone that such a problem, if it did exist, could be solved by using a separate channel for notification information. Indeed, the present invention does **NOT** use a separate channel for the purpose of preventing overloading of an existing session, nor does this argument even make sense. The invention uses a separate channel so that the migrator can still communicate its changes to the non-migrator even after the IP address change occurs (Applicant’s specification, p. 12, lines 8-10). In other words, when an IP address change has occurred at a migrator, and the non-migrator is not aware of this change because the original session no longer provides communication with the migrator, using a separate channel permits the non-migrator to be informed of the IP address change so that it can resume communications with the migrator. In this scenario, the Examiner’s suggestion that overload is an issue or a motivation for combining Gannage and Funato does not make any sense. Overload of the existing session is not an issue, because there is no longer an “existing session” between the migrator and non-migrator once the migrator has changed its IP address – in fact, at that point, there is no “session” at all between the migrator and non-migrator until the non-migrator is made aware of the IP address change and communication resumes at the new IP address. Accordingly, the first motivation provided by the Examiner does not make sense in the context of Funato.

The Examiner still has not addressed, in any office action or in the Examiner’s Answer, the Applicant’s arguments explaining why this first motivation is nonsensical, and it therefore appears that the Examiner has conceded that the Applicant is correct in that this first alleged motivation to combine is improper.

The second motivation that the Examiner continues to allege also makes no sense. The Examiner argues that sending notification messages in a separate out-of-band channel will result in faster data delivery and reduction of transport delays and that “Gannage teaches by reduction the delay found in packet based network during audio conversation over packet-based communication the quality can be improved to carry effective conversation.” The reason why this alleged motivation to combine does not make sense is because Gannage unequivocally states that using a separate channel does not, in fact, reduce transport delays, but actually causes additional delays! As merely one example, Gannage states that there may be an additional delay of one to ten seconds to transmit a fragment of voice data, which Gannage attempts to dismiss as minimal: “The overall experience derived by using our approach is near real time

communication in which one receives a voice message with a small time lag in a pseudo streamed fashion with reasonably good quality. ... In near real time communication, the audio content exchanged between the participants is delayed, but the participants may still carry on an effective conversation or other exchange of audio content. Illustratively, the delay may be greater than one second but less than ten seconds” (§(0030). This shows that the Examiner’s second motivation, reducing delays, is also nonsensical, because Gannage admits that Gannage’s approach adds delay, not reduces delay. Accordingly, the second motivation provided by the Examiner does not make sense in the context of Gannage.

As with the first improper and nonsensical motivation to combine Gannage and Funato, the Examiner still has not addressed, in any office action or in the Examiner’s Answer, the Applicant’s arguments explaining why this second motivation is nonsensical, and it therefore appears that the Examiner has conceded that the Applicant is correct in that this second alleged motivation to combine is also improper.

The Examiner has still provided no valid suggestion or motivation in the prior art for combining Funato and Gannage, nor any valid reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed, and absent such suggestion, motivation, or reason, the Funato and Gannage references cannot properly be combined. Therefore, the pending rejection of claim 1 as obvious over Funato and Gannage is erroneous.

C. Even if Properly Combinable with Funato, Gannage Still Lacks the Teachings for which it is Cited

The Examiner continues to assert erroneously that Gannage teaches “sending a notification message to an endpoint.” This is simply not true and is a mischaracterization of the teachings of Gannage. Gannage uses a separate channel to send voice data, not to provide notification of a change of endpoint address or notification of anything else. It is a fundamental deficiency of Gannage that Gannage does not use a separate channel or “notification channel” to provide *notification* of anything at all! The fact that Gannage discloses the use of a separate channel for one particular purpose, namely, the transmission of voice data, does not, in any way, provide a teaching or suggestion of using a separate channel to provide notification of a change of endpoint address in a method of migrating from one endpoint address to another.

In response to the Applicant’s arguments regarding Gannage’s missing teachings, the Examiner argued erroneously that “[i]n response to applicant’s arguments against the references individually ..., one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of the references,” citing *In re Keller*, 642 F.2d 413 (CCPA 1981) and *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986). The *Keller* and *Merck* cases are not, in any way, applicable to the fact that Gannage does not teach that for which the Examiner cites Gannage. Indeed, in *Ex parte Orlofsky*, Appeal No. 2000-0377 (Application 08/777,841), the Board of Patent Appeals and Interferences made it clear that such attempt to argue *Keller* and *Merck* is not proper where none of the cited references teaches a missing claim element, just as in the present case:

The Examiner states that Appellant's arguments are not persuasive because one cannot show nonobviousness by attacking references individually when the rejection is based on a combination of references (EA7). Appellant responds that the arguments merely show that, even if combined, the claim elements are not shown in the references (RBr1).

We agree with Appellant. Manifestly, if none of the references teach a claimed feature, as shown by addressing the references individually, then the combination of references will also not contain the claimed feature. The admonition against attacking references individually applies where an applicant fails to address the combined teachings of the references.

(emphasis added.) (p. 9.) Although the Applicant recognizes that the *Orlofsky* opinion is not binding precedent of the Board, the logic applied in *Orlofsky* is equally applicable to that of the Applicant's pending appeal. Thus, the Applicant's attack on the Gannage reference individually on the grounds that it does not teach what the Examiner alleges is, in fact, proper.

Accordingly, because Gannage fails to teach that for which it is cited, and the Examiner admits that Funato also fails to teach this feature, even if Gannage and Funato were properly combinable, which they are not, no combination of these references can possibly render claim 1 or any other claim in the application obvious, and this obviousness rejection is clearly in error.

For all these reasons, the Applicant submits that claim 1 is allowable over Funato and Gannage. For similar reasons, the Applicant submits that claims 12 and 20-22 are allowable over Funato and Gannage. Since the rest of the claims depend variously from claims 1 and 12, it is further submitted that those claims are also allowable over Funato and Gannage.

Therefore, it is respectfully submitted that the rejections of claims 1-5 and 8-22 as obvious over Funato and Gannage are in error.

D. Conclusion

For the foregoing reasons, Applicant requests that this appeal be sustained, that the pending rejections be reversed, and that all claims pending in the application be allowed.

Respectfully submitted,

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